

**REMARKS/ARGUMENTS**

Claims 1-81 were pending in the application. Claims 14-25 and 52-61 are allowed, claims 29-31, 37, 44-49, 63, 66 and 67 are objected to and claims 1-13 26-28, 32-36, 38-43, 50, 51, 62, 64, 65 and 68-81 stand rejected. By this amendment, claims 1, 26, 30, 31, 35, 37, 43, 44, 62, 63, 66, 67, 68, 75 and 81 are amended, claims 12 and 29 are canceled and claims 82 and 83 are newly added. Thus, claims 1-11, 13, 26-28, 30-51, and 62-83 are at issue.

As a result of this amendment, the total number of claims in this case has remained the same. However, by this amendment, seven additional independent claims have been added. As a result, applicants enclose a check in the amount of \$1400.00 for the consideration of seven additional independent claims. If there are any additional fees or refunds required, the Commissioner is directed to charge or debit Deposit Account No. 13-2855 of Marshall, Gerstein & Borun LLP. A copy of this paper is enclosed herewith.

Initially, applicants wish to thank the examiner for allowing claims 14-25 and 52-61 and for her recognition of the allowable subject matter in claims 29-31, 37, 44-49, 63, 66 and 67.

**Applicants' Interview Summary Record**

Applicants attorney, Roger A. Heppermann, and agent, Mike Chinlund, conducted a telephonic interview with Examiner Courson on April 20, 2005, at the Applicants' request. Applicants discussed the rejection of claims 1-13, 26-28, 32-36, 38-43, 50-51, 62, and 64-65 as obvious over U.S. Patent Publication No. 2003/0218469 to Brazell et al. ("Brazell") and specifically discussed the location of the connection structure of the instant application and differences relative to any connection features present in Brazell. Applicants and the examiner came to an agreement as reflected in the above-provided amendments for claims 1-13, 26-28, 32-36, 38-43, 50-51, 62, and 64-65.

Additionally, applicants and the examiner discussed the function and operation of the normally open switch of claims 68-81 and discussed the differences and improvements of the claimed switch over the prior art. Applicants and the examiner came to an agreement regarding proposed amendments for claims 68-81.

Furthermore, Applicants agreed to cancel claim 12.

The examiner requested a listing of the proposed claim amendments for her review which was sent via facsimile the following day, April 21, 2005. After reviewing the proposed claim amendments and conducting an additional search, the examiner indicated that the proposed claim amendments would be acceptable.

The claims as listed in this amendment are identical to the proposed claims reviewed by the examiner with the exception of a grammatical correction to claim 67 and antecedent corrections made to claims 75 and 81. Applicants appreciate Examiner Courson's willingness to grant the interview, and for her significant assistance in moving this case towards allowance.

### **Claim Amendments**

Claim 1 is amended to include some of the subject matter of original claim 12. Specifically, claim 1 is amended to include a portion of the connection structure that is pivotably movable relative to the surface. Claim 26 is amended to include some of the subject matter of original claim 29 which was found to include allowable subject matter in the latest office action. Claims 30, 31, 37, 44, 63, 66, and 67 are amended to recite, in independent form, all of the limitations of the claims from which they previously depended. Claims 35 and 62 are amended to include a limitation similar to the amendment of claim 1 with claim 62 being further amended to correct a typographical error. Claims 68 and 75 are amended to further define a surface through which the normally open switch protrudes with claim 75 also being amended to correct antecedent basis of a term therein. Claim 81 is amended to correct antecedent basis of a term therein in light of the amendment to claim 68, from which claim 81 depends. Claims 82 and 83 are new. Support for these amendments can be found in the specification and claims as originally filed. Thus, no new matter has been added. Applicants submit that the claims are now in proper form and in condition for allowance.

### **Objection to the Specification**

Applicants respectfully traverse the objection to the specification. Specifically, the term "biased" has been removed by this amendment from claims 68 and 75. Furthermore, although the term "normally open momentary switch" is not specifically used in the

specification, the function of a normally open momentary switch is described in Paragraph [0056] of the specification as originally filed. Furthermore, the term “momentary switch” is common term in the art and would be recognized by one of ordinary skill in the art as the type of switch described in Paragraph [0056]. Thus, the specification is now in proper form and provides support for each claimed term. Applicants respectfully request withdrawal of the objection to the specification.

### **35 U.S.C. § 112 Rejection**

Applicants respectfully traverse the rejection of claim 12 as indefinite as being moot. By this amendment, claim 12 is canceled.

### **35 U.S.C. § 103 Rejections**

Applicants respectfully traverse the rejection of claims 1-13, 26-28, 32-36, 38-43, 50, 51, 62, 64, and 65 as obvious over U.S. Patent Publication 2003/0218469 to Brazell et al. (“Brazell”) in view of one or more of Brazell and European Patent Application No. EPO 416162 A1 to Chen (“Chen”).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). MPEP 2143.

Each of claims 1-11, 13, 35-36, 38-43, 50, 51, 62, 64 and 65 recites *inter alia*, a stud finder including a surface and a connection structure wherein a portion of the connection structure is pivotably movable relative to the surface. Neither Brazell nor Chen discloses a stud finder including a surface and a connection structure wherein a portion of the connection structure is pivotably movable relative to the surface. While Brazell discloses an object sensor 10 removable from a storage case 300, the object sensor itself does not have any

connection structure. Even if the flat outer walls of the object sensor and the flat inner walls of the case were considered connection structure, no part of this connection structure is movable, let alone pivotably movable with respect to a surface. Furthermore, Chen fails to disclose connection structure of any sort, let alone a portion of connection structure that is pivotably movable relative to a surface. Thus, both Brazell and Chen fail to disclose a stud finder including a surface and a connection structure wherein a portion of the connection structure is pivotably movable relative to the surface as is recited in each of claims 1-11, 13, 35-36, 38-43, 50, 51, 62, 64 and 65. Applicants respectfully request withdrawal of the rejection of claims 1-11, 13, 35-36, 38-43, 50, 51, 62, 64 and 65.

Similarly, each of claims 26-28, and 32-34 recite *inter alia*, a stud finder including a connection structure and a surface wherein the connection structure includes a magnet. Both Brazell and Chen fail to disclose a connection structure including a magnet. Further, the examiner has recognized this feature as being the basis for the allowability of original claim 29. Because both Brazell and Chen fail to disclose a stud finder including a connection structure and a surface wherein the connection structure includes a magnet, as is recited by each of claims 26-28 and 32-34, none of claims 26-28 and 32-34 is obvious over any combination of Brazell and Chen. Thus, Applicants respectfully request withdrawal of the rejection of claims 26-28 and 32-34.

Applicants respectfully traverse the rejection of claims 68-81 as obvious over U.S. Patent Publication 2004/0016058 to Gardiner et al. ("Gardiner") in view of one or more of U.S. Patent No. 6,266,006 to Audet ("Audet") and Chen.

Each of claims 68-74 and 81 recites *inter alia*, a stud finder including a first and second surface, wherein connection structure is disposed on the first surface and a normally open switch protrudes through the second surface and wherein the stud finder operates to locate a structural member through the second surface. None of Gardiner, Audet and Chen discloses a stud finder including a first and second surface, wherein connection structure is disposed on the first surface and a normally open switch protrudes through the second surface and wherein the stud finder operates to locate a structural member through the second surface. Specifically, the examiner acknowledges that Gardiner fails to disclose a normally open switch of any sort.

Further, while Audet discloses an arrow finder including a switch protruding through a handle portion of the arrow finder, the switch of Audet does not protrude through a surface through which the device operates to detect objects, let alone to detect structural members. In fact, the switch of Audet is on a surface opposed to the surface through which the Audet device detects arrows.

Moreover, Chen fails to disclose a normally open switch of any sort, let alone a normally open switch protruding through a surface through which the device operates to detect a structural member. Because Gardiner, Audet and Chen fail to disclose a stud finder including a first and second surface, wherein connection structure is disposed on the first surface and a normally open switch protrudes through the second surface and wherein the stud finder operates to locate a structural member through the second surface, as is recited by each of claims 68-74, none of claims 68-74 is rendered obvious by any combination of Gardiner, Audet and Chen. Applicants respectfully request withdrawal of the rejection of claims 68-74 and 81.

Likewise, each of claims 75-80 recites *inter alia*, a device including a first and a second surface and a normally open switch protruding through the second surface, wherein the second surface is adapted to be disposed adjacent to a structural surface when the device is locating an object behind the structural surface. Gardiner, Audet and Chen fail to disclose a device including a first and second surface and a normally open switch protruding through the second surface, wherein the second surface is adapted to be disposed adjacent to a structural surface when the device is locating an object behind the structural surface.

In particular, Gardiner and Chen fail to disclose a switch of any type protruding through a surface adapted to be disposed adjacent a structural surface. Furthermore, as discussed above regarding the rejection of claims 68-74 and 81, Audet fails to disclose a device that includes a surface adapted to be disposed adjacent a structural member. Still further, the switch of the Audet device protrudes through a surface opposed to the surface through which Audet operates to detect arrows. Because Gardiner, Audet and Chen fail to disclose a device including a first and second surface and a normally open switch protruding through the second surface, wherein the second surface is adapted to be disposed adjacent to a structural surface when the device is locating an object behind the structural surface, as is recited by each of claims 75-80, none of claims 75-80 is rendered obvious by any

combination of Gardiner, Audet and Chen. Therefore, applicants respectfully request withdrawal of the rejection of claims 75-80.

**New Claims 82 and 83**

New claims 82 and 83 depend from claims 68 and 75 respectively, and recite in more detail the operation of the normally open switch. Because claims 68 and 75 are non-obvious over the cited art, claims 82 and 83 are necessarily also non-obvious over the cited art. Therefore, applicants submit that new claims 82 and 83 are in proper form and recite patentable subject matter.

**Power of Attorney**

Applicants enclose a copy of a Revocation of Power of Attorney, New Power of Attorney and Request for Change of Address that was submitted for this application, Patent Application Serial No. 10/612,199, on July 2, 2004. Applicants have reason to believe that this document has not been entered and respectfully request entry of the New Power of Attorney and Request for Address Change.

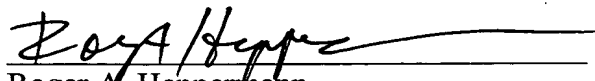
**Conclusion**

Applicants have made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons, Applicants respectfully request reconsideration and allowance of claims 1-11, 13-28 and 30-83.

If there are matters that can be discussed by telephone to further the prosecution of this application, Applicants respectfully request that the examiner call their attorney at the number listed below.

Respectfully submitted,

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